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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,572	02/04/2004	Daniel Ebi	09307.0019	3718

21127 7590 09/12/2006

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EXAMINER

LEWIS, RALPH A

ART UNIT PAPER NUMBER

3732

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/771,572

Applicant(s)

EBI ET AL.

Examiner

Ralph A. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Objection to the Claims

Claims 1-22 are objected to under 37 CFR 1.75(i) which requires each element or step of the claimed invention to be separated by a line indentation.

Rejections based on 35 U.S.C. 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 5, the "in particular" limitation is not understood. Is the limitation a required element of the claim? In line 7, the "via" limitation is confusing.

In claim 2, line 4, the "means" limitation is not understood. Applicant is encouraged to use traditional "means for" language if intending to invoke 35 U.S.C. 112, sixth paragraph.

In claim 5, line 3, the "via" limitation is confusing.

In claims 7 and 8, the "in particular" limitation is confusing. Is the limitation a requirement of the claim?

In claim 13, there is no antecedent basis for "the opening."

In claim 15, the "in particular" limitations are unclear.

In claim 16, the dependency is unclear – a transfer aid is claimed in claim 8, not the “extension piece” as is asserted in the claim. In line 3, the “preferably” limitation is not understood, does the claim require the limitation? Claims set forth what is required by the claim, not what might be required by the claim.

In claims 18, 19, 21 and 22, the “in particular” limitations are confusing.

In claim 23, there is no antecedent basis for “the machined extension piece.”

Rejections based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5 and 11-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Gittleman (US 6,508,650).

Gittleman discloses an extension piece 65/50 for a dental implant 80 having a head part 65 and threaded stem 50 which is to be screwed into the dental implant.

Facets 58 serve as a reference surface for defining the circumferential positioning of the extension piece 65/50. In regard to claim 2, note mating shoulder 57. In regard to claim

3, note transfer aid 66, which snaps to first contour 60. In regard to claim 8, note transfer aid 66. In regard to claims 13 and 14, note holes 70. In regard to claim 15, the extension piece 65 of Gittleman is capable of being machined or ground.

Claims 1-6, 8-18 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Porter et al (US 6,758,672).

Porter et al disclose an extension piece 80 for a dental implant 10. The Porter et al extension piece includes a head part 82 and threaded stem 88. The extension piece 80 includes a reference surface 87 which defines the circumferential position of the extension piece. In regard to claim 3, note transfer aid 150. In regard to claim 4, see cut surface 87 of substantially semi-circular cylinder 80.

Claims 1-4, 8, 11, 12 and 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Behrend (US 5,947,736).

Behrand discloses an extension piece 11 having a head portion and a threaded stem 13 that is to be screwed into an implant. The extension piece includes reference surfaces at 15 that define the circumferential position of the extension piece. In regard to claim 3, note the transfer aid 10.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Behrend (US 5,947,736).

The selection of conventional dental materials for the dental extension piece of Behrend would have been obvious to one of ordinary skill in the art as a matter of routine in practicing the Behrend invention.

Allowable Subject Matter

Claims 19, 20 and 22-25 would be allowable if rewritten in independent form to include all of the limitations of the claims from which they depend and to overcome the rejection based on 35 U.S.C. 112, second paragraph above.

Prior Art

Applicant's information disclosure statement of February 04, 2004 has been considered and an initialed copy enclosed herewith.

Applicant's attention is directed to PTO form 892 making other references of record.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.


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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (571) 272-4720.

R.Lewis
September 5, 2006


Ralph A. Lewis
Primary Examiner
Au3732